



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,097	12/27/2000	Hideki Toshikage	7254/63305	6249

7590

12/21/2005

JAY H. MAIOLI
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,097

Applicant(s)

TOSHIKAGE ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This office action is in response to the RCE filed on October 11, 2005. Claims 1-4 and 18-21 are pending. All the pending claims are amended. Claims 5-17 and 22-39 are canceled.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4 and 18-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "said digital image" in line 5 and "said photographic image data" in line 21. There is insufficient antecedent basis for these limitations in the claim.

Claim 18 recites the limitation "said thumbnail image" in line 27. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-4 and 19-21 are rejected for incorporating the errors of their respective base claims by dependency.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Kagle, U. S. Patent 6,778,760 and Garfinkle et al., U. S. Patent 6,017,187.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception dealer for accepting a sale of said digital image with a handling condition associated with said digital image and for accepting a selection of a receiver side from a plurality of receiver sides, for selling said digital image with said handling condition in a digital data format, and for transferring said digital image with said handling condition in said digital data format to said selected receiver side via an Internet line (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching, and the digital image is delivered in a restricted format at the consumer side according to the handling condition*);
- b) A charge accounting dealer for effecting an electronic charging accounting transaction for the purchase of said digital image with said handling condition in

Art Unit: 3621

said digital data format, and accepting a request from a customer to purchase said digital image (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter does not specifically teach said reception dealer transfers the photographic image data that represent a thumbnail image and further transfers audio data associated with said digital image, said thumbnail image and said audio data being simultaneously played on a portable music player. Kagle teaches transferring audio data associated with the digital image, and the photographic image and said audio data being simultaneously played on a portable music player (column 2 lines 18-61 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter's teaching to include the features of transferring audio data associated with the digital image, and the photographic image and said audio data being simultaneously played on a portable music player for enhancing Ginter's virtual distribution environment.

Ginter modified by Kagle does not specifically teach the photographic image data represent a thumbnail image. However, Garfinkle teaches displaying thumbnail images to a user (column 5 lines 10-29 and column 6 line 56 – column 7 line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the photographic image data in the teaching of Ginter modified by Kagle to be a thumbnail image so that the customer is able to quickly and easily view the image.

As to claim 2, Ginter modified by Kagle and Garfinkle teaches said reception dealer generate predetermined additional information for said digital image and said

Art Unit: 3621

audio data, and distributes said generated additional information in a digital format (Ginter: column 54 lines 26-56; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 3, Ginter teaches said reception dealer distributes said additional information data comprising information as to a payment condition for purchasing said digital image data and audio data, information as to a recorder's history of said digital image data, text information data synthesized with said digital image data (Ginter: column 24 lines 24-53 and column 54 lines 26-56 and column 317 lines 22-42 and column 320 lines 2-20; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 4, Ginter teaches said reception dealer distributes said digital image data and said audio data subjected to a scrambling process (column 59 lines 48-54; Kagle: column 2 lines 18-61 and Fig. 1).

As to claim 18, Ginter teaches an image commercial transactions method comprising (Fig. 1):

- a) An image scanning step for converting a document into a digital image (column 299 lines 36-42);
- b) A publication step of enabling a reception dealer to produce index data displaying a plurality of digital images for sale and publicizes said produced image data via an Internet line (column 7 lines 45-57);
- c) A reception step of enabling a reception dealer to accept a request for a sale of said digital image with a handling condition associated with to said digital image and to accept a selection of a receiver said from a plurality of receiver sides (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and

column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching*);

d) A sale step of enabling said reception dealer to sell said digital image with said handling condition in a digital data format (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and Figs. 1, 15A);

e) A transferring step for transferring said digital image with said handling condition in said digital data format to said selected receiver side via said Internet line (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, this limitation corresponding to the digital image is delivered in a restricted format at the consumer side according to the handling condition in Ginter's teaching*);

f) A charge accounting step of enabling a charge accounting dealer to effect an electronic charge accounting transaction for a purchase of said digital image with said handling condition in said digital data format (column 55 lines 44-60 and column 58 lines 3-63 and Figs. 1A, 3-4).

Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanning step for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanning step is for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanning step for converting a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanning step in Ginter's teaching include

the feature of converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

Ginter does not specifically teach a thumbnail image. However, Garfinkle teaches displaying thumbnail images to a user (column 5 lines 10-29 and column 6 line 56 – column 7 line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to Ginter to include the feature of a thumbnail image so that the customer is able to quickly and easily view the image.

Ginter modified by Garfinkle does not specifically teach handle an audio data associated with the digital image, said thumbnail image and said audio data being simultaneously played on a portable music player. This matter is taught by Kagle as simultaneously playing digital image with associated audio data on a portable music player (column 2 lines 18-61 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ginter modified by Garfinkle to include the features of simultaneously playing digital image with associated audio data on a portable music player for enhancing Ginter's virtual distribution environment.

Claims 19-21 are rejected for the similar reasons as claims 2-4.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gibbens et al. (U. S. Patent 5,877,842) discloses digital dailies.

Art Unit: 3621

Peters et al. (U. S. Patent 6,618,547) discloses electronic film editing system using both film and videotape format.

Takehiko et al. (U. S. Patent 6,741,795) discloses digital video disc player and apparatus for displaying images.

Yager et al. (US 2003/0011627 A1) discloses providing a multimedia presentation.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung
Patent Examiner
Art Unit 3621
December 16, 2005



**MARY D. CHEUNG
PRIMARY EXAMINER**